

Notice of Allowability

Application No.

10/753,293

Examiner

Marc S. Zimmer

Applicant(s)

WALKER ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 08/11/06 and the interview conducted 10/30/06.
2. ☒ The allowed claim(s) is/are 1,2,4,5,8,9 and 11-17.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Charles Almer on October 30, 2006.

The application has been amended as follows:

Please replace all previous versions of claim 1 with,

1. A crosslinkable organosilicon polymer composition comprising vinyl-terminated polydimethylsiloxane and between 1 and 80 wt.% of a silicon hydrocarbon crosslinking agent, wherein the crosslinking agent comprises alternating structures of polycyclic polyene residues and cyclic or tetrahedral siloxysilane residues.

Please cancel claims 3, 6, and 7.

Also, please amend the Specification by inserting the following immediately after the title,

-- This Application is a continuation-in part, U.S. Application Serial no. 09/993,589, now U.S. Patent No. 6,841,647. --

Applicant had been had been advised of the following issues that represented obstacles to the patentability of this case in the aforementioned interview:

(i) the only component mentioned in their Specification that adheres to the description of a resin bearing both carbon-carbon double bonds and silicon-bound hydrogen atoms is the silicon hydrocarbon crosslinking agent itself. That is to say, the Specification, in the Examiner's estimation, did not support a claim directed to a composition that contained both (A) a resin featuring carbon-carbon double bonds and silicon-bound hydrogen atoms alike and (B) a silicon hydrocarbon crosslinker inasmuch as only the crosslinker is identified by the Specification as containing both of these structural attributes. Applicant's "SUMMARY OF INVENTION" outlines what the Examiner believes to be the three primary embodiments of the invention and none of these include combining a silicon hydrocarbon crosslinker with a polysiloxane having carbon-carbon double bond substituents and silicon-bound hydrogen substituents. It had, therefore, been recommended that Applicant remove mention of the "polysiloxane resin having both reactive carbon-carbon double bonds and silicon-bound hydrogen atoms" as an embodiment of the base polymer that is reacted with the crosslinking agent.

(ii) claim 1, as it was presented in Applicant's August 11 correspondence, was interpreted as being directed merely to a composition comprising a vinyl-functional siloxane polymer and what amounted to a carbosiloxane crosslinking agent bearing

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complimentary Si-H groups. This interpretation was predicated on the Examiner's view that, in the context of Applicant's Specification, a "silicon hydrocarbon crosslinking agent" could be reasonably defined as any polymer having in its backbone repeat units contributed by a source of siloxane (Si-O-Si) groups and repeat units derived from a source of divalent hydrocarbon residues provided, of course, that the polymer also contained the necessary silicon-bound hydrogen atoms. Put more succinctly, the silicon hydrocarbon crosslinking agent was defined as a carbosiloxane polymer containing SiH groups for Examination purposes.

In an updated/modified survey of the prior art, the Examiner encountered Takuman et al., U.S. Patent # 6,180,704 and Grate et al., U.S. Patent # 6,991,887. Applicant had been advised that these references were believed to represent a foundation for the rejection of at least the previous version of claim 1 because each of them described a composition comprising an alkenyl group-functional polyorganosiloxane and a carbosiloxane polymer having silicon-bonded hydrogen atoms. The Examiner suggested that Applicant might consider amending claim 1 to include the limitations of claim 7 as a means of avoiding a prior art rejection over these references, particularly since every favored permutation of Applicant's invention had employed those crosslinkers that had been identified in claim 7. Applicant indicated their willingness to make this modification of claim 1. Both parties agreed that the Examiner would make the necessary changes.

Claims 3 and 6 were cancelled because the Specification had not specified whether the molecular weight associated with the vinyl-functional polydimethylsiloxane was a weight-average molecular weight or a number-average molecular weight. Neither Applicant nor the Examiner could ascertain where proper support for this limitation might originate because there was no express support for this limitation nor was there any mention of a commercial product that would inherently be in possession of this property.

Walker et al., U.S. patent # 6,841,647 is cited as being of interest for its quite similar disclosure of compositions comprising phenyl- or fluoroalkyl-substituted siloxane base polymers and identical crosslinking agents. There is, however, no mention of the employment of polydimethylsiloxane either as an alternative or supplement to these materials nor could the Examiner envisage why it would have been obvious to add/substitute a polydimethylsiloxane. Indeed, it is stated in that disclosure that the desired properties are obtained in no small part due to the presence of phenyl/fluoroalkyl substitution.

The references cited during this prosecution are the most germane known. Insofar as they fail to even render obvious the claimed invention, claims 1-2, 4-5, 8-9, and 11-17 are considered allowable.

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The Examiner sincerely appreciates all of Applicant's cooperation in bringing resolution to this case.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



MARC S. ZIMMER
PRIMARY EXAMINER

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

October 30, 2006